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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,026	02/02/2000	Katsumi Tahara	450100-2952.2	6986
20999	7590	03/17/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			DIEP, NHON THANH	
			ART UNIT	PAPER NUMBER

2613

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/497,026

Applicant(s)

TAHARA ET AL

Examiner

Nhon T Diep

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/02/2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/477,855.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Reissue Applications***

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon. In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, in addition, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required. It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to

merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. See 37 CFR 1.175(a)(1) and MPEP § 1414.

2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The declaration refers to "I"; however, there are two signatures signed at the end of the declaration. Please submit a new declaration to change "I" to "We";

Even though, there is a statement to offer the surrender of the Letters Patent No. 5,715,009; however, the Original Patent is not surrendered and is not included in the file as of now;

The declaration fails to state whether the inventor is sole or joint as required by 37 CFR 1.63(a)(4).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-47 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tahara (US 5,743,380).

Tahara (different inventive entity) discloses the same picture signal transmitting method and apparatus as of the present reissue application (Tahara et al) and therefore claims 1-47 of Tahara et al are rejected as being clearly anticipated by Tahara since both disclose an identical specification.

5. Claims 28-33 and 38-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Eyuboglu et al (US 5,537,440).

Eyuboglu et al discloses an efficient transcoding device comprising the same encoding apparatus for encoding source video data which had previously been encoded at a previous encoding process and had previously been decoded at a previous decoding process (fig. 3), the apparatus comprising means for receiving the source video data (fig. 3, el. 304); means for extracting coding information from the source data, wherein the coding information relates to a coding operation of the previous encoding process (fig. 10, output of el. 1002 to el. 1022, 1020 and 1010); and means for encoding the source video data in accordance with the coding information (el. 1010) as specified in claims **28, 29, 30, 31 and 44-47** and means for receiving picture coding type indicating which of I-picture, P-picture or B-picture had been associated with the previous coding process (fig. 10, output of el. 1002: framing inter/intra) as specified in claims **32 and 33**,; a decoding apparatus for decoding an encoded bit stream which had been encoded at the previous encoding process, the apparatus comprising means for extracting coding information from the encoded bit stream, wherein the coding

information relates to a coding operation of the previous encoding process; means for decoding the encoded bit stream to generate decoded video data in accordance with the coding information (fig. 3, el. 304 and col. 4, ln. 25-33: "achieve the performance of decode"); and means for transmitting the decoded video data and the coding information so that the coding information will be used in a later encoding process for the decoded video data (fig. 10, outputs of el. 1002) **38, 39, 40 and 41** and wherein the picture coding type indicates which of I-picture, P-picture or B-picture had been associated with the previous coding process (fig. 10, output of el. 1002: framing inter/intra) as specified in claims **42 and 43**,

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eyuboglu et al.

As applied to claim 38 above, it is noted that Eyuboglu et al does not particularly disclose a multiplexer for multiplexing the decoded video data and the coding information to generate multiplexed data; and means for transmitting the multiplexed data so that the coding information will be used in a later encoding process as specified in claims 34-37. Eyuboglu et al shows that outputs of the decoder (fig. 10, el. 1002) can be directly fed to adder 1004 and encoder 1010 without the need of multiplexing these

outputs and separating them again at later step. As a matter of designer's choice and/or efficiency, it would have been obvious to one of ordinary skilled in the pertinent art at the time the invention was made to either feed both outputs of el 1002 separately or multiplexing them and separating them later.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Auld (US 5,452,006) discloses a two-part synchronization scheme for digital video decoders.

b. Chen (US 5,327,520) discloses a method of use of voice message coder/decoder.

c. Tomita et al (US 5,291,484) discloses a relay and exchange system for time division multiplex data.

d. Kretz et al (US 4,292,651) discloses an expansion and compression of television signals by use of differential coding.

e. Kurobe et al (US 5,479,212) discloses a picture data coding apparatus.

f. Koppelman et al (US 5,544,266) discloses a transcoder device.

g. Zhu et al (US 5,534,937) discloses a minimum-delay jitter smoothing device and method for packet video communication.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T Diep whose telephone number is 703-305-4648. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S Kelley can be reached on 703 305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703 87209314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-2600.

ND  
11 March 2004



**NHON DIEP**  
**PRIMARY EXAMINER**